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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,011	06/04/2004	Jan Hall	21547/0286	9980
7590 Burton A Amernick Connolly Bove Lodge & Hutz P O Box 19088 Washington, DC 20036-0088			EXAMINER SWEET, THOMAS	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 06/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/980,011

**Applicant(s)**

HALL ET AL.

**Examiner**

Thomas J. Sweet

**Art Unit**

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 22-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### ***Response to Arguments***

Applicant's arguments, see pg 10, filed 03/10/2008, with respect to the rejections under 35 U.S.C. 112 have been fully considered and are persuasive. The rejection of claims 1-10 and 22-25 has been withdrawn.

Applicant's arguments see pg 10, filed 03/10/2008, with respect to the declaration have been fully considered and are persuasive. The objection to the declaration has been withdrawn.

The double patenting rejections will be maintained until such time that they are rendered moot.

Applicant's arguments with respect to claims 1-10 and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 8 of U.S. Patent No. 7048541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in intended use which claims 1-3, 5 and 8 (541) inherently meet.

Claims 1-6, 8-10 and 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-9 of copending Application No. 10/482727. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in intended use which claims 1 and 7-9 (727) inherently meet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6, 8-10 and 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-5, 7 and 10 of copending Application No. 10/482737. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in intended use which claims 4-5, 7 and 10 (737) inherently meet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 29 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 9. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim

to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-10, 22-23, 25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al (US 6447550). Hunter et al discloses an implant (abs) comprising titanium and having one or more surfaces which can be applied in or on tissue areas and/or bone growth areas, one or more of the said surfaces being arranged with a depot for bone-growth-initiating (Osseointegration col 4, lines 16-19 and lines 39-44) or bone-growth-stimulating substance (non-elected member of this Markush group), which depot is formed by a pore arrangement in a relatively thick oxide layer on the titanium (3-7 and up to 10 microns thick of approx. 2 micron dia. grains forming pores in between, col 6-7, lines 66-17), characterized in that the substance (non elected) , for a period of time, is acted on by, or works with, one or more release functions which permit a preferably essentially controlled release of substance to the respective surrounding tissue or tissue/bone growth areas.

Regarding claims 2, 4 and 5, rejected as being directed to a non-elected member of the Markush group.

Regarding claims 3 and 6, pores with different pore characteristics (inherent, random size and distribution).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al.  
Hunter et al discloses an implant as discussed above including a highly pores oxide layer.  
However, Hunter et al does not expressly disclose with  $1 \times 10^7 - 1 \times 10^{10}$  pores/cm<sup>2</sup>. it has been held that it is not inventive to discover the optimum or workable ranges by routine experimentation and would be an obvious extension of the prior art teachings.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al in view of Larsson et al (US 6689170). Hunter et al discloses an implant as discussed above.  
However, Hunter et al does not disclose titanium based oxide coating. Larsson et al teaches another implant using a titanium based oxide coating in the percentages of about 20% titanium, 55% oxide and 20% carbon for the purpose of being biocompatible and promoting tissue growth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the titanium based oxide of Larsson et al for the oxide of Hunter in the thicknesses setout by hunter so that pore are formed in the oxide in order to be biocompatible and promote tissue growth. Such of modification amounts to mere substitution of one functionally equivalent oxide coating material for another within the art of implants (prosthetics).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:45am - 5:15pm, Tu-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas J Sweet/  
Primary Examiner, Art Unit 3774